

**REMARKS**

This reply is in response to the Office Action dated August 17, 2005. Claims 1-25, 27-35, 38-43, and 46-83 are pending in the application and stand rejected. Applicant has amended the claims above to clarify aspects of the invention. Applicant has also amended the claims above to correct matters of form and/or to correct grammatical/typographic errors. Entry of the foregoing amendment and reconsideration of the claims is respectfully requested.

Claims 1-25, 27-35, 38-43, and 46-83 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dias et al. (WO/ 02/48257 A2) (hereafter Dias"). The Examiner states that "Dias discloses with sufficient specificity the presently claimed carbon black in the presently claimed amounts.

Applicant has amended the claims as shown herein to more clearly recite aspects of the invention, obviating the rejection. Specifically, Applicant has amended the base claims to recite 20 to 100 phr of an elastomer comprising at least 30 mol% of isobutylene (a specific amount and a specific type of isooolefin); 80 to 200 phr of carbon black having a surface area of less than 30 m<sup>2</sup>/g and a dibutylphthalate oil absorption of less than 80 cm<sup>3</sup>/100 gm (a specific amount and a specific type of carbon black); and 2 to 40 phr of polybutene oil (a specific amount and a specific type of oil). That specific combination of components surprisingly and unexpectedly provides a significant improvement in air impermeability (over 30% increase) without a sacrifice in processability, as shown in the Examples. See, for example, Examples 18-20 and 24-26.

Dias generally discloses various amounts of elastomer, carbon black and processing oil, as noted by the Examiner. However, Dias does not disclose with "sufficient specificity" a composition comprising 20 to 100 phr of an elastomer comprising at least 30 mol% of isobutylene; 80 to 200 phr of carbon black having a surface area of less than 30 m<sup>2</sup>/g and a dibutylphthalate oil absorption of less than 80 cm<sup>3</sup>/100 gm; and 2 to 40 phr of polybutene oil, as required in the amended claims. Therefore, the ranges disclosed and exemplified in Dias, when taken as a whole, do not provide the "sufficient specificity" required by MPEP 2131.03 to support an anticipation rejection under 35 U.S.C. § 102. Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

Furthermore, the claimed subject matter is not obvious in view of Dias. The Examiner is kindly reminded that a particular parameter must first be recognized as a variable which achieves a recognized result before the determination of the optimum or workable ranges of said variable

might be characterized as routine experimentation. *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Further, "That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness. *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997), *cert. denied*, 119 S. Ct. 56 (1998).

Here, Applicant has discovered a significantly improved balance of elastomer processability and air impermeability of the elastomer compositions falling within the limitations of the claims, as discussed in paragraphs [00101], [00103], [00104], [00106], and [00109], and the examples which show over a 30% improvement in air impermeability without a sacrifice in processability. Therefore, the claims are not obvious in view of Dias if for no other reason than the claimed subject matter provides the unexpected results discussed above. For at least these reasons, withdrawal of the rejection and allowance of the claims is respectfully requested.

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. Applicant invites the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been addressed to the Examiner's satisfaction. A petition for extension of time for filing this response is attached; however, in the event that petition becomes separated from this Response, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 05-1712, for any fees, including extension of time fees or excess claim fees, required to make this response timely and acceptable to the Office.

Respectfully submitted,

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Date



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